

Response Under 37 CFR §1.116
Expedited Procedure
Examining Group 1700
Application No. 09/890,438
In reply to USPTO Correspondence of October 15, 2004
Paper Dated: January 14, 2005
Attorney Docket No. 1214-011212

REMARKS

Claims 16, 19 and 21-26 are currently pending in this application. Claims 1-15 were canceled by Preliminary Amendment. Claims 17, 18 and 20 were canceled and new claims 24-26 were added in a previous Amendment dated July 29, 2004. This Amendment amends claims 16 and 24-26. Support for the amendments to the claims can be found in the specification and claims as originally filed. No new matter has been added.

As suggested by the Examiner in a telephone conversation dated November 16, 2004, claim 16 has been amended to replace the term "comprises" with the phrase "consisting of." Furthermore, claims 24-26 have been amended to overcome the §112 rejections. The amendments to the claims are believed to place this case in condition for allowance. Therefore, entry of the amendments to claims 16 and 24-26 is respectfully requested.

The Examiner has objected to claim 26 under 37 C.F.R. § 1.75(c) as being in improper dependent form for failing to limit further the subject matter of a previous claim. The Examiner asserts that claim 25 does not encompass epoxy compounds as recited in dependent claim 26. In response, claim 26 has been amended to change its dependency from claim 25 to claim 24. In view of the above, withdrawal of the objection to claim 26 is respectfully requested.

The Examiner has objected to claims 24-26 under 35 U.S.C. § 112, second paragraph, for indefiniteness. First, the Examiner asserts that it is unclear whether claim 24 is a method of use claim having a step of polymerization, or an article claim reciting a cationically polymerized material containing the specified polymerization initiator. In response, claim 24 has been amended to recite an article (i.e., product claim). Specifically, claim 24 recites "a reaction system comprising the polymerization initiator as claimed in claim 16 and a cationically polymerizable organic substance." The preamble of dependent claims 25 and 26 has also been amended to recite a "reaction system." Support for the amendatory language (i.e., reaction system) can be found, for example, in the last line on page 12 of the present specification.

Secondly, the Examiner asserts that the phrase "a compound or mixture of at least two compounds" in claim 25 is unclear as to the relationship between the first-mentioned "compound" and the later mentioned "two compounds." In response, claim 25

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has been amended into two separate Markush groups. Support for the amendment to claim 25 can be found, for example, in the sixth paragraph on pages 14 and 15 of the present specification.

The Examiner also asserts that the phrases “polyacetal compounds” and “polyamide compounds” are unclear. The terms polyacetal and polyamide compounds are common terms that have a clear definition. Furthermore, with the amendment to claim 25, it is now clear that these compounds are the resulting materials of the claimed cationically polymerizable organic substance.

Lastly, the Examiner asserts that the phrase “is selected from a group consisting of organosiloxane compounds, epoxy compounds and mixtures thereof” in claim 26 is unclear. In response, claim 26 has been amended to clarify that the cationically polymerizable organic substance is selected from a group consisting of organosiloxane compounds and epoxy compounds and mixtures of organosiloxane compounds and epoxy compounds. In view of the foregoing, reconsideration and withdrawal of the rejections of claims 24-26 are respectfully requested.

The Examiner has finally rejected claims 16, 19 and 21-25 under 35 U.S.C. § 102(e) for anticipation by U. S. Patent No. 6,100,352 to Shouzaki et al. (hereafter “the Shouzaki patent”) for the same reasons as discussed in the previous Office Action dated January 29, 2004. Claims 16, 19 and 21-25 stand finally rejected under 35 U.S.C. §103(a) for obviousness over the Shouzaki patent for reasons discussed on pages 5 and 6 of the final Office Action. The Examiner asserts that the Shouzaki patent teaches a complex comprised of dimethyl ferrocenium tetrakis(pentafluorophenyl) borate, as well as other ferrocenium and borate base complexes for the purpose of polymerization catalyst. Furthermore, the Examiner asserts that the transitional term “comprises” does not exclude the presence of additional ingredients of the initiator as claimed in claim 16. To overcome the rejection of the claims, the transitional term “comprises” has been replaced with the transitional phrase “consisting of.” This amendment, as suggested by the Examiner, is believed to place the claims in condition for allowance. In view of the above, reconsideration and withdrawal of the rejection of claims 16, 19 and 21-25 are respectfully requested.

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In view of the foregoing amendments and remarks, Applicant believes that claims 16, 19 and 21-26 are patentable over the prior art of record and are in condition for allowance. Entry of the amendments to claims 16 and 24-26 is respectfully requested.

Respectfully submitted,

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